

S/N: 10/785,509

Atty Dkt No. GP-303795/GM0439PUSP

Remarks

This Amendment is intended to be fully responsive to the Office Action mailed September 19, 2005.

In this Action, the Examiner has rejected claims 1-11 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, the Examiner has objected to the use of "type". Those skilled in the art know that a "rotating-type torque transmitting mechanism" is a clutch, and a "nonrotating-type torque transmitting mechanism" is a brake. Nonetheless, the word "type" has been removed with the present Amendment.

The Examiner has also rejected claims 1, 2 and 4 under 35 U.S.C § 103(a) as being unpatentable over Sugiura in view of Dairokuno. A proper rejection under 35 U.S.C. § 103(a) requires that the Examiner establish *prima facie* obviousness. As recited in the MPEP, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142.

The Examiner is reminded that three basic criteria must be met to establish *prima facie* obviousness. MPEP § 2143. First, there must be some suggestion or motivation to modify a reference or combine teachings. *Id.* Second, there must be reasonable expectation of success. *Id.* Third, the prior art reference or references must teach or suggest all the claim limitations. *Id.*

The rejection of claim 1 is improper because the Examiner has not provided an adequate motivation or suggestion to combine the teachings of Sugiura with Dairokuno, and thus the first criterion necessary to establish *prima facie* obviousness is not satisfied. In the Office Action, the Examiner states that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the torque rotating mechanisms of Sugiura et al. with a bearing disposed between the piston and plate in view of Dairokuno et al. to provide rotatable support for the piston." (See Office Action, page 3)

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However, there is no teaching in Dairokuno et al. of providing “rotatable support for the piston” as the Examiner states. The bearing (47) of Dairokuno et al. is provided merely to accommodate the slight relative rotation of the first and second cam plates 35, 37. Referring to column 13, lines 13-18 of Dairokuno et al., “...the needle bearing 47 is interposed between the first cam plate 35 and a separator plate 13 in order to smoothly make the relative rotations between the first cam plate 35 and the second cam plate 37...” Dairokuno et al. is silent regarding rotatably supporting a piston. Rather, the bearings 47 of Dairokuno et al. merely accommodate slight rotation of the cam members. There is no reason to believe that one skilled in the art would look to the teachings of Dairokuno et al. to accommodate high-speed rotation between an apply piston and an apply plate, as in the present application. The split-cam arrangement of Dairokuno et al. is an obscure, functionally different design with no apparent, or motivated, value in the development of the present invention, and the Examiner has failed to provide proper motivation for the combination with Sugiura.

Further, regarding the third criterion for *prima facie* obviousness, the prior art does not teach or suggest all of the claim limitations. Specifically, Dairokuno et al. does not teach “an apply plate rotatable with at least one portion of said first torque-transmitting mechanism”, as required by claim 1. The Examiner states that element 13 is an “apply plate”, but it is clearly identified as a “separator plate” in the specification. See, for example, column 13, lines 13-18 of Dairokuno et al., “...the needle bearing 47 is interposed between the first cam plate 35 and a separator plate 13 in order to smoothly make the relative rotations between the first cam plate 35 and the second cam plate 37...” The separator plate 13 is inside the clutch pack and is therefore not a piston apply member. Dairokuno et al. teaches no apply plate rotatable with at least one portion of the first rotating torque-transmitting mechanism, as required by claim 1.

Accordingly, Applicants submit that the rejection of claim 1 is improper. Claims 2-4 ultimately depend from claim 1 and are therefore allowable for at least the same reasons that claim 1 is allowable.

The Examiner has further indicated that claims 5-9 and 11 would be allowable of rewritten or amended to overcome the rejection under 35 USC 112, 2<sup>nd</sup> paragraph.

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Accordingly, with this Amendment, these claims are allowable, as indicated by the Examiner.

In light of these Remarks and this Amendment, it is respectfully submitted that all claims are in condition for allowance, which action is requested.

Respectfully submitted,

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